

REMARKS

Claims 1, 3, 4, 6-14, and 16-22 are pending, and Claims 2, 5 and 15 have been canceled. No changes or amendments have been made to the pending Claims.

This application was filed on April 6, 2001, and after the Applicant responded to numerous office actions and discussed the application with the Examiner, the Examiner indicated that all pending claims were allowable in a notice sent on February 11, 2003. In the October 14, 2003 Office Action, however, the Examiner asserted that the claims he previously indicated were allowable now violate the recapture rule and rejected all of the pending Claims. The Applicant disagrees and requests that the Examiner consider the following remarks and remove these grounds for rejection.

A. THE REISSUE CLAIMS DO NOT RECAPTURE SURRENDERED SUBJECT MATTER

The Examiner rejected Claims 1, 4, 9 and 17 under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter surrendered in the original application. Specifically, with respect to Claims 1, 4, 9, and 17, the Examiner states that "the limitation that the plate and the fin are rectangular in shape is improperly omitted." The Examiner also states that, with respect to Claims 4, 9, and 17, "the limitation that the plate [has] two sides spaced no further apart than [the] overall width of the hard drive" is improperly omitted. The Applicant traverses this rejection at least because (1) the purportedly broadened aspects of the reissue claims were not surrendered, and (2) even if they were surrendered, the reissue claims maintain their "fundamental narrowness."

**1. The Purportedly Broadened Aspects Of The Reissue Claims
Were Not Surrendered**

To determine whether there was surrender of claimed subject matter, one must consult the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. *In re Clement*, 131 F.3d 1464, 1469 (Fed. Cir. 1997). The Applicant must have "made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable" for there to be surrender. *Ball Corp. v. U.S.*, 729 F.2d 1429, 1436 (Fed. Cir. 1984). And, there must be "evidence that the applicant's amendment was 'an admission that the scope of that claim was not in fact patentable, . . .'" *Clement*, 131 F.3d at 1469 (*quoting Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984)). Further, even if subject matter was surrendered, the recapture rule only applies if the surrendered subject matter made its way into the reissue claims. *Clement*, 131 F.3d at 1469.

Here, non-"rectangular" shaped plates and fins and plates not having "two sides spaced no farther apart than the overall width of said hard drive" were not surrendered during prosecution of the original application. The Applicant did not make a judgment that claims without the limitations would have been unpatentable; and, there is no evidence showing that the Applicant made such a judgment. A review of the prosecution history brings this to light.

As noted in the June 25, 1998 and September 17, 1998 Amendments (First and Second Amendments, respectively), the disclosed invention pertains to heat sinks that are used in conjunction with disk drives positioned within computer storage systems. The invention makes the disk drives easier to handle and reduces the volume occupied by the disk drives. The primary reference cited in the Original Application was U.S. Patent No. 5,311,928 by Marton. As described in the First and Second Amendments, Marton discloses fins that project upwardly from opposed marginal edges of a plate.

Marton also discloses other embodiments in which the edges are bent at various angles, affecting the angles at which the fins protrude. First Amendment at 2-3; Second Amendment at 2-3.

The Applicant noted that "[d]isposing the fins in this position makes it more difficult" to handle the component (First Amendment at 2-3) and that such a configuration results in "considerable space [being] occupied by the fins" (Second Amendment at 3). The Applicant amended original Claim 8 "to define the difference between the **location** of the louvers in applicant's structure and that shown in the reference Marton." Second Amendment at 4 (emphasis added). Specifically, the Applicant amended Claim 8 to specify that the fins extend from "within" the plate as opposed to protruding from edges that extend from the plate, as shown in Marton. First Amendment at 2-3; Second Amendment at 3-4.

Moreover, the Applicant did not distinguish Marton in any way by relying on the shape of the plate or fin, as asserted by the Examiner. Thus, the Applicant did not make a deliberate judgment that claims without the "rectangular" limitation would be unpatentable. *Ball*, 729 F.2d at 1436; *Clement*, 131 F.3d at 1469. As a result, the Applicant requests that the Examiner remove this basis for rejection.

The Applicant likewise did not make a deliberate judgment that reissue claims without the "two sides spaced no farther apart than the overall width of said hard drive" language would be unpatentable. The originally filed claims included language that "a plate hav[e] a shape to fit over the drive." June 26, 1997 Original Application. The language was eventually changed to the "two sides spaced no farther apart than the overall width of said hard drive" in a Supplemental Amendment that was made per a September 29, 1998 discussion with the Examiner. September 29, 1998 Supplemental Amendment After Final. "[T]he definiteness of the wording" of original Claim 8 was discussed during the discussion – not the "scope" of the claims. *Id.* Indeed, the language both before and after the Supplemental Amendment covers about the same scope of subject matter. Thus, the "two sides spaced no farther apart" language does

not in any way evidence a judgment by the Applicant that the reissue claims would be unpatentable without such an amendment. *Ball*, 729 F.2d at 1436; *Clement*, 131 F.3d at 1469. As a result, the Applicant requests that the Examiner remove this basis for rejection.

In view of the foregoing, the Applicant asserts that Claims 1, 4, 9 and 17, and Claims 3, 6-8, 10-14, 16, and 18-24, which depend therefrom, do not violate the recapture rule and request that the Examiner remove this basis for rejection.

2. The Reissue Claims Maintain Their “Fundamental Narrowness”

Even if the Examiner concludes that subject matter claimed in the reissue application was surrendered during prosecution of the original application over the Applicant's objection set forth above, the Applicant may overcome the recapture rule if they added limitations that do not deprive the reissue claims of “fundamental narrowness” of scope relative to the claims in the original application. *Ball*, 729 F.2d at 1438. Put another way, “[i]f the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of surrendered subject matter, there can be no recapture.” MPEP § 1412.02 at 1400-15; *see also Hesther Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998) (stating that, with respect to surrender of subject matter by way of argument, an Applicant may “overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention.”); *Mentor*, 998 F.2d at 996 (applying recapture rule because “the added limitations do not narrow the claims in any material aspect with respect to their broadening.”). “The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.” *Hesther Indus.*, 142 F.3d at 1482-83.

The *Ball* case is instructive. In *Ball*, the patentee initially claimed “electrical

signal feed means" and amended the application to claim a "*plurality* of electrical signal feed means" to distinguish the claims from a prior art reference. *Ball*, 729 F.2d at 1432-1433. In the reissue application, the patentee amended the application to claim a "*single electrical feed assembly*." *Id.* at 1437. The Court found that, although the patentee added "plurality" to "signal feed means" to distinguish prior art, the patentee was still permitted to claim a "single electrical signal assembly" in the reissue application because he narrowed the claim by changing "means" to "assembly." *Id.*

Likewise, in this case, the reissue claims retained their "fundamental narrowness" of scope notwithstanding the Examiner's erroneous conclusion that certain shapes of the plate and fins were surrendered by way of the "rectangular" and "spaced no farther apart" language. Specifically, in Claims 1, 4, and 9, the shape of the "plate" was narrowed by language stating that the "plate" or "planar thermal conductive region" comprise "a depression located to contact said motor when said plate is attached to said hard disk drive" was added. In Claim 17, the shape of the plate was narrowed by language stating that the "shield," which comprises the "plate," is "attached to said hard disk drive" was added. As a result, the reissue claims maintained their "fundamental narrowness" and do not violate the recapture rule. The Applicant therefore asserts that Claims 1, 4, 9 and 17, and Claims 3, 6-8, 10-14, 16, and 18-24, which depend therefrom, are allowable and request that the Examiner remove this basis for rejection.

B. The Invention Of Claim 17 Was Disclosed In The Original Patent

The Examiner rejected Claim 17 under 35 U.S.C. § 251 and asserts that Claim 17 is directed to a different invention and lacks sufficient support in the specification. The Applicant traverses this ground of rejection. Claims presented in the reissue application satisfy the invention disclosed in the original patent requirement where one skilled in the art, reading the specification of the original patent, would identify the subject matter of the new claims as invented and disclosed by the patentees. MPEP §

1411.02 at 1400-12 (*citing In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991)).

In this case, Claim 17 is directed toward a "computer storage system" comprising "a hard disk drive" and "a shield" that comprises "a plate" and "a plurality of louvers." The specification of the Original Patent (U.S. Patent No. 5,892,655) would clearly show to one skilled in the art that the Applicant invented and disclosed the "computer storage system" claimed in the reissue application. For example, the Original Patent discloses that the invention includes a plate used with a hard disk drive: "the invention relates to a **louvered plate** which is **fixed to a disk drive** to dissipate heat and protect the user." Original Patent at 1:5-10 (emphasis added). The Original Patent also discloses that the invention includes a computer storage system by disclosing that the disk drive is used with a computer: "the invention relates to a louvered plate which . . . protect[s] the user and also the **disk drive components** from damage if the heat sink is installed or removed while the **computer** to which it is attached is energized." *Id* (emphasis added). At least because the language shown above shows that the Applicant invented and disclosed the "computer storage system" claimed in the reissue application, the Applicant asserts that Claim 17 is sufficiently supported and is not an invention different than the one shown in the Original Patent. As a result, the Applicant asserts that Claim 17 and Claims 18-22 and 24, which depend from Claim 17, are allowable. The Applicant therefore requests that the Examiner remove this ground for rejection.

In view of the foregoing, the Applicant respectfully submits that Claims 1, 3, 4, 6-14 and 16-24 are in condition for allowance and that all of the stated rejections have been addressed. Withdrawal of the stated grounds for rejections and a timely Notice of Allowability are solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

Serial No. 09/828,246
January 14, 2004
Page 13

While the Applicant believes that no fees are due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in the fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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